

REMARKS

Reconsideration and further examination of the subject patent application in light of the present Amendment and Remarks is respectfully requested. Claims 1-22 are currently pending in the application. Claims 1-22 stand rejected.

Rejections under 35 U.S.C. §103

Claims 1-22 have been rejected under 35 U.S.C. §103(a) as being anticipated by U.S. Pat. Publ. No. US 2003/0028518 to Mankoff in view of U.S. Pat. Appl. No. US 2004/0049427 to Tami et al. and U.S. Pat. No. 5,945,653 to Walker et al. Applicant respectfully traverses this rejection.

Independent claims 1, 11 and 20 have been further limited to the method step of (and apparatus for) "searching a database using the identifier of the item to identify a coupon that provides a discount on a purchase price of the item to any consumer when used with a predetermined credit card provided by the sponsoring credit card company". Support for identification of a coupon based upon the item identifier may be found within the Specification at paragraph [0023]. Support for the fact that the discount is available to any consumer when used with the predetermined credit card is inherently taught in the Specification by paragraphs [0025-26].

In contrast (and as admitted by the Examiner), "Mankoff discloses a paperless coupon redemption system in which a coupon is associated with a customer's credit card [0015]" (Office Action of 8/10/05, page 2). Associating a coupon with a customer's credit card is completely different than associating a coupon with a product identifier.

For example, under Mankoff "list owners . . . may have . . . credit card information" (Mankoff, par. [0011]). To implement the Mankoff system "the list manager transmits the email address and offer identifier to the matching agent, which then associates the email address with the consumer's associated credit card and adds the coupon identifier to the consumer's coupon data base for later matching to a retail good or service transaction in which the consumer redeemed the promotional offer" (Mankoff, par. [0013]). The consumer may accept the coupon through the Internet (Mankoff, par. [0014]). However, the consumer must still present their credit card or other payment system at the point of sale to redeem the coupon.

Coupons systems that rely upon consumer credit card information pose an inherent risk for consumers and are unnecessarily complicated. Further, they do not allow the possibility of joint promotional opportunities between credit card companies and manufacturers since the credit card company is not involved.

None of the cited references of Mankoff, Tami et al. or Walker et al. (or the combination) provide any teaching regarding "searching a database using the identifier of the item to identify a coupon that provides a discount on a purchase price of the item to any consumer when used with a predetermined credit card provided by the sponsoring credit card company". In addition, Mankoff could not be modified to do so without changing an essential aspect of Mankoff (i.e., the use of credit cards or other payment systems for identification of coupons).

Since at least this element is not taught or suggested by reference of the combination, the combination fails to teach or suggest each and every claim limitation. Since the combination fails to teach each and every claim limitation, the rejections are improper and should be withdrawn.

Closing Remarks

For the foregoing reasons, applicant submits that the subject application is in condition for allowance and earnestly solicits an early Notice of Allowance. Should the Primary Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, the Primary Examiner is respectfully requested to call the undersigned at the below-listed number.

The Commissioner is hereby authorized to charge any additional fee which may be required for this application under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920. A duplicate copy of this sheet(s) is enclosed.

Respectfully submitted,
WELSH & KATZ, LTD.

By 

Jon P. Christensen

Registration No. 34,137

October 13, 2005
WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500